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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,302	08/08/2000	Ramkumar Subramanian	E0796	5052
29393	7590	02/11/2005	EXAMINER	
ESCHWEILER & ASSOCIATES, LLC NATIONAL CITY BANK BUILDING 629 EUCLID AVE., SUITE 1210 CLEVELAND, OH 44114			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,302

Applicant(s)

SUBRAMANIAN ET AL.

Examiner

Richard A Rosenberger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11, 13, 17-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8-11, 17-22, 24 is/are allowed.
- 6) ☐ Claim(s) 13 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13 and 25 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshiyama (US 5,644,399).

The systems of figure 1a, 3 and 6 of Hoshiyama shows an optical measuring device (image sensor 3) to view an object along an optical path and an optical indicia device (scale plate 4) located in the optical path. The scale plate 4 is transparent and has non-transparent indicia thereon. The structure of the scale plates inherently provide location information with respect to any observable feature of on the object, including defects.

Those in the art could chose any lens system which is appropriate for the application at hand for imaging the article and the scale plate onto the image detector, including a microscope. Providing means to adjust and/or remove the scale plate would have been obvious; the embodiment of figure 4 of the reference shows that it is known that it is useful to be able to view the article without viewing the scale, which is the purpose of the shutter 8B. In systems in which the scale lies physically between the article and the sensor, the obvious and straightforward

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manner of achieving this desired result is to simply remove the scale plate. This would simplify the construction and reduce the cost by eliminating the half mirror and the shutter.

3. The argument in the remarks filed 19 November 2002 concerning the rejection of claims 13 and 25 above have been considered, but have not been found to be persuasive. The Hoshiyama reference clearly teaches being able to obtain images of the object and the superimpose scale and of the object only, and provides means to accomplish this. This is a teaching of effectively removing the optical indicia device from the optical path, and a suggestion of actually removing it. There is clearly every reasonable expectation of success in effectively removing the optical indicia device from the optical path by actually removing it from the optical path; none in the art would imagine that physically removing the optical indicia device would not effectively remove it as taught by Hoshiyama.

4. Claims 8-11, 17 through 22, and 24 appear to be allowable.

The art does not appear to teach or suggest having "an optical indicia device located in the optical path" and movable "between a first position in the first plane, and a second position in a second plane, and wherein the second plane is parallel with the first plane" as in claim 8 and claims 9-11 as dependent therefrom..

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The art does not appear to teach or suggest the use of such a optical indicia device in a method involving correlation of defects between different workpieces as in claims 17 and 22, and claims 18-21 as dependent from claim 17.

The art does not appear to teach or suggest the use of such an optical indicia device in a method involving comparison between tow portions of a workpiece as in claim 24.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
14 November 2003



Richard A. Rosenberger
Primary Examiner